

#15

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Antoni P. Tomsia et al.

Appl. No.: 09/845,597

Filed : April 30, 2001

Title : Glass/Ceramic Coatings for Implants

Grp./Art Unit: 1775

Examiner: Sperty, Arden B.

Docket No.: IB-1627



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INTERVIEW SUMMARY RECORD

All participants:

- 1) Deborah Jones
- 2) Charles R. Nold

Date of Interview: July 16, 2003

Type: Telephonic

Exhibit shown or conducted: no

Claims discussed: all

Identification of Prior art discussed: Provisional patent application 60/201,556

Agreement with respect to the claims: no agreement was reached

REMARKS

This interview summary record is being submitted on August 15, 2003. Entry into the record is respectfully requested.

Applicant's requested the interview and provided four talking points for discussion.

The Examiners refused to tell Applicant's what was wrong with the specification, and specifically state how the specification does not meet the requirement of 35 U.S.C. 112 first paragraph. Applicants reminded the Examiners four times that they had a duty to explain how the specification was "deficient", but the Examiner's would not come forth with any reason, merely stating that a compilation of references "is not a specification".


The Examiners own interview summary record shows the mistake the Examiners have made in this examination when they repeatedly state "Counsel is graciously invited to show support in the provisional application for the claimed invention" and "Counsel was invited to show support in those documents for the claimed invention, not just one element".

At one point, Henry P. Sartorio asked the Examiners, if, upon examination of the provisional, was it true that they really couldn't see support for the invention? This question drew no response, except that Deborah Jones said she would look at it again.

The premature finality was not discussed.

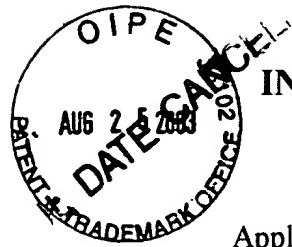
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Respectfully Submitted,


Charles R. Nold
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Telephone No. 510 486-6503

09/845,597



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INTERVIEW SUMMARY RECORD

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- 2) Deborah Jones
- 3) Charles R. Nold
- 4) Henry P. Sartorio

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REMARKS

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This interview took place approximately 5 hours after the first interview, and was thus the second interview of the day.

Deborah Jones said that the claims were not supported in two limitations:

1. Ms. Jones stated that the provisional only had support for the recitation of a glass/Hydroxyapatite mixture of 50/50.
2. Ms. Jones stated that the provisional only had support for the glass/hydroxyapatite layer being the outer layer.
3. No other reasons were given.

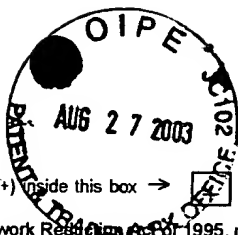
The premature finality was discussed. The reason given for the premature finality was the following: The provisional specification consisted of four journal articles. These four journal articles were cited by applicant on an IDS submitted with the application. The Examiner was not told by applicant that the provisional application consisted of four journal articles that were cited on an IDS. Thus, when the Examiner discovered this, after doing a first office action, a Final Rejection was deemed proper. There was no agreement between the Examiner and applicant on this theory.

Respectfully Submitted,



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1775

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/845,597
	Filing Date	April 30, 2001
	First Named Inventor	Antoni P. Tomsia
	Group Art Unit	1775
	Examiner Name	Sperty
Total Number of Pages in This Submission	5	Attorney Docket Number IB-1627

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Fee Attached	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Amendment / Response	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	1. two interview summary records, both for July 16, 2003
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Small Entity Statement	
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Response to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Charles R. Nold; Lawrence Berkeley National Laboratory
Signature	C R Nold
Date	8/15/03

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: 08/15/2003			
Typed or printed name	Charles R. Nold		
Signature	C R Nold	Date	8/15/03

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